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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/930,539

08/14/2001

Rodney M. LaFollette

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02/16/2005

EXAMINER

Foster & Foster, LLC

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Salt Lake City, UT 84102

ART UNIT PAPER NUMBER

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 09/930,539	Applicant(s) LAFOLLETTE ET AL.	
	Examiner Raymond Alejandro	Art Unit 1745	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 06 December 2004 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file a complete new brief in compliance with 37 CFR 41.37 within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

see next page.

Raymond Alejandro
 Examiner
 Art Unit: 1745

DETAILED ACTION

This Notification of Non-Complaint Appeal Brief is being provided in response to the Appeal Brief filed on 12/06/04.

In this regard, it is noted that under 37 CFR 1.191(a), an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee set forth in 37 CFR 1.17(b) within the time period provided under 37 CFR 1.134 and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice or finally...rejected" does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application (*See MPEP 1205 Notice of Appeal*).

In this instance, the present appeal brief fails to meet the requirement of having the claims twice rejected simply because the appealed claims and their intended subject matter have never been rejected by the examiner. That is to say, the intended amendment of 10/14/04, the substitute amendment of 11/01/04, and the supplemental amendment of 11/09/04 incorporating new limitations into the claims (*i.e. the specific foot print area as low as 0.001 cm² in claim 21; and the specific footprint within a range of less than 1 cm² to 0.0001 cm² and the connotation of the micro-fabricated limitation in claim 33*) were never made of record and officially entered due to its non-compliant condition as set forth in various Notices of Non-Compliant Amendment

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dated 10/22/04 and 11/15/04 identifying the lack of a complete listing of all of the claims, and/or in the Failure to Acceptably Respond to Notice of Non-Compliant Amendment of 11/23/04. The foregoing non-compliant communications were issued by the Technical Support Team of PTO, and they do not reflect, in any way, an official examination on the merits of claims. Thus, since the appealed claims include non-entered amendments and unexamined subject matter, it is contended that the appealed claims have not been considered and examined on their merits. Additionally, the appeal is not in compliance with 37 CFR 41.31(a)(1) in that no claim has been twice rejected.

In consequence, the appeal brief is defective as it unfairly appeals subject matter never entered and made of record by PTO; and ultimately, never considered and examined on the merits by the examiner. To remedy this defectiveness, applicant is suggested to either: a) cancel or delete the intended new limitations (the limitations newly added in the amendment not-entered) so as to fairly appeal the examiner's rejection based on the original claimed subject matter of the current application; or b) withdraw the appeal brief and allow the application continues its regular course of action and examination. If applicant desires to adopt any of aforementioned suggestions or any other action, applicant is still reminded of his obligation to submit a proper reply addressing this issue so as to avoid an abandonment due to applicant's failure to offer a proper reply timely filed.

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